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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/658,525	09/10/2003	Hitoshi Yoshino	03500.009931.7	5353

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EXAMINER

SCHWARTZ, PAMELA R

ART UNIT PAPER NUMBER

1774

DATE MAILED: 10/30/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/658,525

Applicant(s)

YOSHINO ET AL.

Examiner

Pamela R. Schwartz

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 08 August 2006.  
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 44-53 is/are pending in the application.  
4a) Of the above claim(s) 53 is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 44-52 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) 44-53 are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.  
10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.  
5) ☐ Notice of Informal Patent Application (PTO-152)  
6) ☐ Other: \_\_\_\_\_.

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1. Newly submitted claim 53 is directed to species that are independent or distinct from the invention originally claimed. Therefore, the following election of species is required.

This application contains claims directed to the following patentably distinct species: wherein the alumina hydrate contains titanium dioxide or any one of the metal oxides recited by claim 53. The species are independent or distinct because they each require a distinct oxide be present.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 44, 45, and 47-52 are generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which depend from or otherwise require all the limitations of an allowable generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species.

MPEP § 809.02(a).

Since applicant has received an action on the merits for the originally presented species, this species has been constructively elected by original presentation for

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prosecution on the merits. Accordingly, claim 53 is withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 44 and 50-51 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-11 of U.S. Patent No. 5,869,177 for reasons of record and for reasons given below.

3. Claims 44 and 47 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-11 of U.S. Patent No. 5,869,177 in view of Oberlander et al. (4,360,449) for reasons of record and for reasons given below.

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4. Claims 45 and 49-51 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-14 of U.S. Patent No.

5,800,916 for reasons of record and for reasons given below.

5. Claims 45 and 47 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-14 of U.S. Patent No. 5,800,916 in view of Oberlander et al. (4,360,449) for reasons of record and for reasons given below.

6. Claims 44-46 and 48-52 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-18 of U.S. Patent No.

5,851,654 for reasons of record and for reasons given below.

7. Claims 44-47 and 52 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-18 of U.S. Patent No. 5,851,654 in view of Oberlander et al. (4,360,449) for reasons of record and for reasons given below.

8. Claims 44-46 and 48-52 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-29 of U.S. Patent No.

5,846,647 for reasons of record and for reasons given below.

9. Claims 44-47 and 52 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-29 of U.S. Patent No. 5,846,647 in view of Oberlander et al. (4,360,449) for reasons of record and for reasons given below.

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10. Claims 45 and 49-51 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-23 of U.S. Patent No. 5,962,124 for reasons of record and for reasons given below.

11. Claims 45 and 49 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-23 of U.S. Patent No. 5,962,124 in view of Oberlander et al. (4,360,449) for reasons of record and for reasons given below.

12. Claims 44 and 50-51 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-17 of U.S. Patent No. 5,635,291 for reasons of record and for reasons given below.

13. Claims 44 and 47 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-11 of U.S. Patent No. 5,635,291 in view of Oberlander et al. (4,360,449) for reasons of record and for reasons given below.

14. Claim 46 and 50-52 are rejected under 35 U.S.C. 103(a) as being unpatentable over applicants' admissions of pages 1-6 and 44 of applicants' specification for reasons of record and for reasons given below.

15. Claims 46-52 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention for reasons of record and for reasons given below.

16. In all of the above rejections, coating amounts of claims 50 and 51 are conventional and would have been obvious to one of ordinary skill in the art.

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17. Applicant's arguments filed August 8, 2006 have been fully considered but they are not persuasive. Applicants argue that the method steps of the claims "would not necessarily have been obvious to one having ordinary skill in the art at the time of the invention." The examiner is citing four references to show the state of the art at the time of applicants' invention. The references disclose preparing a recording medium by applying an aqueous dispersion of pigment and binder to a support or by incorporating the composition into the pulp slurry of a paper making process. See USPN 4,946,741 to Aono et al., col. 6, lines 47 to col. 7, line 23, USPN 4,425,405, to Murakami et al., col. 4, lines 27-57, USPN 4,857,386 to Butters et al., col. 3, lines 14-30, and USPN 4,903,039, to Light, col. 4, lines 46-54. While these references do not disclose an alumina hydrate containing dispersion, they all disclose the instantly claimed method steps for applying or incorporating a dispersion of binder and particles as part of the paper-making slurry or as an aqueous coating on a support for ink jet recording. Therefore, these methods of applying a binder and particle dispersion would have been obvious to one of ordinary skill in the art at the time of applicants' invention because they were conventional methods in the art.

In addition, the examiner has carefully considered the language in the specification and the amendment to claim 46. The term "contains" normally has a meaning in the art that is broad enough to include mixing or adding components together, the examiner looked to see if the term was defined to have a special meaning within applicants' specification. The term has been used in a description in the specification, but a clear definition of how applicants are using the term has not been

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set forth. Therefore, the term must be given its broadest meaning and broader meanings are not excluded. Consequently, the rejections under 35 USC 103 and 112 have been maintained. These rejections could be overcome by incorporating language from pages 44 and 45 of the specification that indicates the position of the titanium dioxide within the pores of the alumina hydrate.

18. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

19. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pamela Schwartz whose telephone number is (571) 272-1528.

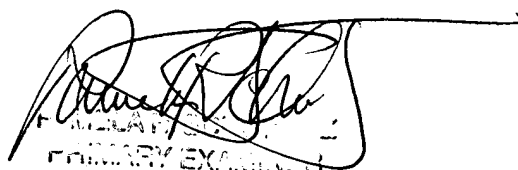


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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye, can be reached on (571) 272-3186. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

PRSchwartz  
October 24, 2006



PRIMARY EXAMINER